

1 STEPHEN P. SWINTON (106398)  
J. CHRISTOPHER JACZKO (149317)  
2 COOLEY GODWARD LLP  
4401 Eastgate Mall  
3 San Diego, CA 92121  
Telephone: (858) 550-6000  
4 Facsimile: (858) 550-6420

5 R. WILLIAM BOWEN, JR. (102178)  
GEN-PROBE INCORPORATED  
6 10210 Genetic Center Drive  
San Diego, CA 92121-4362  
7 Telephone: (858) 410-8918  
Facsimile: (858) 410-8637

8 Attorneys for Plaintiff  
9 GEN-PROBE INCORPORATED

10 UNITED STATES DISTRICT COURT  
11 SOUTHERN DISTRICT OF CALIFORNIA  
12

13 GEN-PROBE INCORPORATED,

14 Plaintiff,

15 v.

16 VYSIS, INC.,

17 Defendant.  
18  
19  
20

No. 99CV2668 H (AJB)

**NOTICE OF MOTION AND MOTION OF GEN-  
PROBE INCORPORATED FOR PARTIAL  
SUMMARY JUDGMENT OF NON-INFRINGEMENT  
UNDER THE DOCTRINE OF EQUIVALENTS**

Date: November 13, 2001

Time: 10:30 a.m.

Dept.: Courtroom 1

21 **TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD HEREIN:**

22 PLEASE TAKE NOTICE that on November 13, 2001 at 10:30 a.m. in Courtroom 1 of the  
23 above entitled court located at the United States Courthouse, 940 Front Street, San Diego,  
24 California 92101, plaintiff Gen-Probe Incorporated ("Gen-Probe") will and hereby does move the  
25 Court under Federal Rule of Civil Procedure, Rule 56 for partial summary judgment under Counts  
26 One and Three of its Second Amended Complaint that its nucleic acid test for human  
27 immunodeficiency virus ("HIV") and hepatitis C virus ("HCV") does not infringe the claims of  
28 U.S. Patent No. 5,750,338 (the "338 patent") under the doctrine of equivalents. The grounds of

1 this motion are that there is no disputed issue of material fact that Gen-Probe's HIV and HCV test  
2 kit does not contain each of the claim limitations of the '338 patent and thus does not infringe that  
3 patent. In particular, the methods and kits claimed in the '338 patent are limited to using only non-  
4 specific amplification methods. Gen-Probe's HIV and HCV test kit, on the other hand, uses a  
5 method of specific amplification which performs a substantially different function in a  
6 substantially different way to achieve a substantially different result from non-specific methods of  
7 amplification.

8 This Motion is based on this Notice of Motion and Motion, the accompanying  
9 Memorandum of Points and Authorities, the Declaration of Dr. Matthew Longiaru, the Declaration  
10 of Kary B. Mullis, Ph.D., the Declaration of Michael Harpold, Ph.D., the Notice of Lodgment, and  
11 on such other and further oral and documentary evidence as the Court may consider at the time of  
12 the hearing.

13 Dated: October 16, 2001

14 STEPHEN P. SWINTON  
15 J. CHRISTOPHER JACZKO  
16 COOLEY GODWARD LLP

17 R. WILLIAM BOWEN, JR.  
18 GEN-PROBE INCORPORATED

19 By:   
20 Stephen P. Swinton

21 Attorneys for Plaintiff  
22 GEN-PROBE INCORPORATED  
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**PROOF OF SERVICE**  
**(FRCP 5)**

I am a citizen of the United States and a resident of the State of California. I am employed in San Diego, State of California, in the office of a member of the bar of this Court, at whose direction the service was made. I am over the age of eighteen years, and not a party to the within action. My business address is 4401 Eastgate Mall, San Diego, California 92121. On the date set forth below I served the documents described below in the manner described below:

1. NOTICE OF MOTION AND MOTION OF GEN-PROBE INCORPORATED FOR PARTIAL SUMMARY JUDGMENT OF NON-INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS
2. MEMORANDUM OF POINTS AND AUTHORITIES OF PLAINTIFF GEN-PROBE INCORPORATED IN SUPPORT OF ITS MOTION FOR PARTIAL SUMMARY JUDGMENT OF NON-INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS
3. DECLARATION OF DR. KARY B. MULLIS IN SUPPORT OF GEN-PROBE INCORPORATED'S MOTION FOR PARTIAL SUMMARY JUDGMENT OF NON-INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS
4. SEPARATE STATEMENT OF UNDISPUTED FACTS IN SUPPORT OF PLAINTIFF GEN-PROBE INCORPORATED'S MOTION FOR PARTIAL SUMMARY JUDGMENT OF NON-INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS
5. NOTICE OF LODGMENT IN SUPPORT OF PLAINTIFF GEN-PROBE INCORPORATED'S MOTION FOR PARTIAL SUMMARY JUDGMENT OF NON-INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS

☐ (BY U.S. MAIL) I am personally and readily familiar with the business practice of Cooley Godward LLP for collection and processing of correspondence for mailing with the United States Postal Service, and I caused such envelope(s) with postage thereon fully prepaid to be placed in the United States Postal Service at San Diego, California.

☐ (BY MESSENGER SERVICE) by consigning the document(s) to an authorized courier and/or process server for hand delivery on this date. See attached Proof of

Personal Service.

☒ (BY FACSIMILE) I am personally and readily familiar with the business practice of Cooley Godward llp for collection and processing of document(s) to be transmitted by facsimile and I caused such document(s) on this date to be transmitted by facsimile to the offices of addressee(s) at the numbers listed below.

☒ (BY OVERNIGHT MAIL) I am personally and readily familiar with the business practice of Cooley Godward llp for collection and processing of correspondence for overnight delivery, and I caused such document(s) described herein to be deposited for delivery to a facility regularly maintained by Federal Express for overnight delivery.

on the following part(ies) in this action:

Thomas W. Banks, Esq.  
Finnegan, Henderson, Farabow, Garrett &  
Dunner, LLP  
245 First Street, 18<sup>th</sup> Floor  
Cambridge, MA 02142  
Tel: (617) 444-8508  
Fax: (617) 444-8608  
Attorneys for Vysis, Inc.

John H. L'Estrange, Jr. Esq.  
Wright and L'Estrange  
701 B Street, Suite 1550  
San Diego, CA 92101  
Tel: (619) 231-4844  
Fax: (619) 231-6710  
Attorneys for Vysis, Inc.

**VIA FACSIMILE & OVERNIGHT  
SERVICE**

Charles Lipsey, Esq.  
L. Scott Burwell, Esq.  
Finnegan, Henderson, Farabow, Garrett &  
Dunner, LLP  
1300 I Street, N.W.  
Washington, DC 20005-3315  
Tel: (202) 408-4000  
Fax: (202) 408-4400  
Attorneys for Vysis, Inc.

~~VIA FACSIMILE & PERSONAL SERVICE~~

**VIA FACSIMILE & OVERNIGHT  
SERVICE**

Executed on October 16, 2001, at San Diego, California.

  
Sylvia M. Tether

1 **PROOF OF PERSONAL SERVICE**

2  
3 I hereby declare:

4 I am employed in the City of Diego, County of San Diego, California; I am over the age of  
5 eighteen years and not a party to the within cause; my business address is Knox Services, 2201  
6 East Fourth Street, Santa Ana, California 92711-1960. On October 16, 2001, I served the within:

- 7  
8 1. NOTICE OF MOTION AND MOTION OF GEN-PROBE INCORPORATED FOR PARTIAL  
9 SUMMARY JUDGMENT OF NON-INFRINGEMENT UNDER THE DOCTRINE OF  
10 EQUIVALENTS  
11 2. MEMORANDUM OF POINTS AND AUTHORITIES OF PLAINTIFF GEN-PROBE  
12 INCORPORATED IN SUPPORT OF ITS MOTION FOR PARTIAL SUMMARY JUDGMENT OF  
13 NON-INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS  
14 3. DECLARATION OF DR. KARY B. MULLIS IN SUPPORT OF GEN-PROBE  
15 INCORPORATED'S MOTION FOR PARTIAL SUMMARY JUDGMENT OF NON-  
16 INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS  
17 4. SEPARATE STATEMENT OF UNDISPUTED FACTS IN SUPPORT OF PLAINTIFF GEN-  
18 PROBE INCORPORATED'S MOTION FOR PARTIAL SUMMARY JUDGMENT OF NON-  
19 INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS  
20 5. NOTICE OF LODGMENT IN SUPPORT OF PLAINTIFF GEN-PROBE INCORPORATED'S  
21 MOTION FOR PARTIAL SUMMARY JUDGMENT OF NON-INFRINGEMENT UNDER THE  
22 DOCTRINE OF EQUIVALENTS

23 on the interested parties in this action by personally hand delivering a copy of said document(s) to  
24 the address(es) listed below:

24 John H. L'Estrange, Jr. Esq.  
25 Wright and L'Estrange  
26 701 B Street, Suite 1550  
27 San Diego, CA 92101  
28 Tel: (619) 231-4844  
Fax: (619) 231-6710

Attorneys for Vysis, Inc.

1 I declare under penalty of perjury under the laws of the State of California that the  
2 foregoing is true and correct, and that this declaration was executed on October 16, 2001.

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5 SIGNATURE: \_\_\_\_\_

6 PRINT NAME: \_\_\_\_\_  
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